

Remarks

Claims 8 and 19 are amended. No new subject matter is added. Claims 7-15 and 19-24 remain pending in the application. Reconsideration and allowance of the pending claims is requested in light of the following remarks.

Specification Objections

The specification is objected to because amended claims 22-24 recite “an article of computer-readable media,” which, according to page 3 of the OA, is a phrase that does not find clear support or antecedent basis in the specification. The applicant submits that this is not an objection to the specification, per se, but rather a rejection of claims 22-24 because the specification does not satisfy the written description requirement of 35 U.S.C. 112, first paragraph, in relation to those claims. See, e.g., MPEP 2163(I): “[t]he issue ... is most often phrased as whether the original application provides ‘adequate support’ for the claims at issue,” and “[m]ost typically, the issue will arise in the context of determining whether ... amended claims are supported by the description of the invention in the application as filed.”

The function of the written description requirement is to ensure that the inventor had possession of, as of the filing date of the application relied on, the specific subject matter later claimed by him or her; how the specification accomplishes this is not material. MPEP 2161.01(I). For amended claims there is no in haec verba requirement, but the newly added limitations must be supported in the specification by express, implicit, or inherent disclosure. MPEP 2163(I)(B). The phrase “an article of computer-readable media” as recited in claim 22 has express support in the disclosure. See, e.g., the discussion of “machine-readable code” at page 10, lines 10-16.

Since the written description requirement is not an in haec verba requirement, and since the limitation at issue is expressly supported by the specification, the applicant submits that one of ordinary skill would recognize that the inventor did have possession of, as of the filing date, “an article of computer-readable media” as recited in claim 22. Furthermore, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention as defined in the claims. MPEP 2163(II)(A). Such evidence or reasoning is not present in the OA.

The OA at page 3 also quotes extensively from MPEP 2111.01(IV), regarding the inventor's ability to define specific terms that are used to describe the invention. But note that strictly speaking, none of this discussion is applicable to the identified claim terms because the inventor did not provide in the specification a definition of "an article of computer-readable media" as recited in claims 22-24. The OA itself recognizes that this ability is optional (e.g., "[w]hile the inventor may define specific terms ..."). In the absence of an express attempt to impart a novel meaning to the claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. MPEP 2111.01(III). For the above reasons, withdrawal of the objection to the specification is requested.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claim 8 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that subject matter that the applicant regards as the invention, and for failing "to point out what is included or excluded by the claim language." In particular, the OA identifies a feature recited in claim 8 - "an application programming interface in accordance with Network Processing Forum" - as being indefinite.

Claim 8 is amended. The amendment is fully supported by the original application at, e.g., page 7, lines 10-11. It is believed that the amendment resolves the issues identified by the OA, and withdrawal of this rejection to claim 8 is requested.

Claims 7-15 and 19-24 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that subject matter that the applicant regards as the invention, and for failing "to point out what is included or excluded by the claim language." In particular, the OA identifies a phrase that appears in claims 15, 19, and 22 - "a control portion of the control plane protocol module that is separate and distinct from the core functionality" - as being indefinite for the above reasons. The applicant respectfully disagrees.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35

U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. MPEP 2173.02, emphasis added. When claims 15, 19, and 22 are evaluated as a whole, it should be evident that the allegedly indefinite phrase is functionally describing a component that is positively recited in the claims, in particular, the worker control plane protocol module. The allegedly indefinite phrases as they appear in context with the worker control plane protocol module are “at least one forwarding plane having a worker control plane protocol module to implement a portion of the control plane protocol module that is separate and distinct from the core functionality” (claim 15, emphasis added) and “wherein the worker control plane protocol module implements a portion of the control plane protocol module that is separate and distinct from the core functionality on at least one forwarding plane” (claims 19 and 22, emphasis added).

The reasoning provided at page 5 of the OA for the rejection of these claims is that “there is no description of what portion is implementing a separate and distinct [functionality] from the core functionality.” To the contrary, when the claims are read as a whole, it is clearly stated that the worker control plane protocol module implements the portion of the control plane protocol module that is separate and distinct from the core functionality. In other words, “the portion of the control plane protocol module” isn’t doing the implementing, it is the worker control plane protocol module that is implementing “the portion of the control plane protocol module.” For this reason, the applicant submits that the claim language has met the threshold requirements of clarity and precision that are required to provide clear warning to others as to what constitutes infringement of the patent. Withdrawal of the rejection is requested.

Claim Rejections – 35 U.S.C. 101

Claims 7-15 stand rejected under 35 USC 101 as being directed to non-statutory subject matter. The applicant respectfully disagrees.

The OA at page 6, upon inspection of pages 10-11 of the specification, concludes that the “control plane, forwarding plane, and modules are nothing more than software components.” This is incorrect. Please also consider page 3, line 15, to page 4, line 22, where the recited control plane, forwarding plane, and backplane are described as physical network elements and not merely software running on the network elements.

Furthermore, even if the other recited elements of claim 15 (the infrastructure module and the communication library) are considered to be nothing more than software components, this still does not make the claim non-statutory. See, e.g., MPEP 2106.01(I): “Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim.” For the above reasons, withdrawal of the 35 U.S.C. 101 rejection is requested.

Claim Rejections – 35 U.S.C. 103

Claims 7-15 and 19-24 are rejected under USC 103(a) as being unpatentable over U.S. Pub. No. 2002/0165961 to Everdell (“Everdell”) and further in view of U.S. Pat. No. 6,999,454 to Crump (“Crump”). The applicant respectfully disagrees.

The Supreme Court has identified a number of rationales to support a conclusion of obviousness that are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*. MPEP 2143, citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___ 35 USPQ2d 1385, 1395-1397 (2007). The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. MPEP 2143. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. MPEP 2143.

The rationale provided by the OA at pages 6-12 for supporting the conclusion of obviousness for claims 7-15 and 19-24 appears most closely akin to the *KSR* rationale of combining prior art elements according to known methods to yield predictable results. MPEP 2143(A). To reject a claim under this rationale, the examiner must articulate several findings, one of which includes the finding that the prior art included each element claimed. MPEP 2143(A). If this finding cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art. MPEP 2143(A).

Claim 19 is amended to correct an antecedent basis problem identified in the claim. Claim 15 recites at least one forwarding plane having a worker control plane protocol module to implement a portion of the control plane protocol module that is separate and distinct from

the core functionality. Claims 19 and 22 recite that the worker control plane protocol module implements a portion of the control plane protocol module that is separate and distinct from the core functionality on at least one forwarding plane. Thus, the claims do not merely require the worker control plane protocol module to implement a portion of the control plane protocol that is separate and distinct from the core functionality, they additionally require that the worker control plane protocol module implement said portion on at least one forwarding plane.

At page 7 of the OA, Everdell is alleged to disclose the feature of at least one forwarding plane that includes the worker control plane protocol module, but recognizes at page 8 that Everdell fails to disclose the worker control plane protocol module implementing a portion of the control plane protocol module that is separate and distinct from the core functionality. Rather, Crump is alleged to teach this feature because Crump states “the control plane is split into box management control functions and routing control functions” (column 6, lines 55-65).

Even if the alleged teachings of Everdell and Crump identified above are combined as suggested, it would still not include the identified elements of claims 15, 19, and 22. Crump may teach that the control plane is split into separate functions, but it still does not teach implementing a portion of the control plane protocol module that is separate and distinct from the core functionality on at least one forwarding plane.

The OA at page 14 denies this, indicating that Crump FIGS. 5 and 6 disclose that said portions are implemented separately, which leads to the conclusion that Everdell-Crump disclosed “a forwarding plane implementing a portion of the control plane functions.” But this ignores Crump’s teaching at column 6, lines 36-38, which states that “the fourth generation router 600 supports a distributed control plane that runs independently of the forwarding plane,” clearly implying that the router 600 does not implement anything on the forwarding plane. Within the fourth generation router 600, the control plane is separated into routing control functions (distributed across the cards 610 and 640) and box management control functions (isolated to the card 610), where the cards 610 and 640 are all part of the router 600 (FIG. 6; column 6, lines 27-32; emphasis added). Crump cannot teach implementing control plane functions on the forwarding plane if the router 600 supports a distributed control plane that runs independently of the forwarding plane.

For at least the reason identified above, the finding that the prior art included each element claimed cannot be made. Consequently, the rationale provided in the OA is insufficient to support a conclusion of obviousness for claims 15, 19, and 22. MPEP 2143(A). Claims 7-14, 20-21, and 23-24 are allowable at least because any claim that depends from a nonobvious independent claim is also nonobvious. MPEP 2143.03.

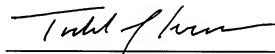
Conclusion

For the reasons presented above, reconsideration and allowance of the pending claims is requested. Please telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Customer No. 32231

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

A handwritten signature in black ink, appearing to read "Todd J. Iverson", is written over a horizontal line.

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